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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P1637

electronically filed

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Typed or printed name BRENT CAPEHART

Application Number

10/720,418

Filed

November 24, 2003

First Named Inventor

Skaggs, Ray

Art Unit

1754

Examiner

Wartalowicz, P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 39,620

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34


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28 APR 06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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PATENT
Docket No. P1627

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: RAY SKAGGS

SERIAL No. 10/720,418

EXAMINER: WARTALOWICZ, P.

FILED: NOVEMBER 24, 2003

ART UNIT: 1772

TITLE: REMOVABLE FLEXIBLE PANEL

COMMISSIONER FOR PATENTS
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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper sets forth the reasons for the Pre-Appeal Brief Request. These reasons list out omissions of one or more essential elements needed for a prima facie rejection.

Claims 1, 3, 4, 6, 7, 10, 12, 13, and 15-22 are currently pending. All pending Claims were rejected under 35 U.S.C. § 103(a) as being unpatentable in light of Rylander (USPN 4749011) in view of Steinmetz (USPN 5884454) and Mezzanotte (USPN 3736973). This request is to concisely identify at least one omission of one or more essential elements needed for a prima facie rejection.

Claims 1, 16 and 21 are independent claims, with Claim 1 being the broadest. It reads as follows:

A removable internal support for a flexible container having an open end, said support comprising:
a panel of generally flat planar configuration having a first surface, a second surface, a top edge, a bottom edge, and a

pair of opposed lateral edges and constructed from a first material sufficiently flexible for responding to pressure against one face thereof for deforming into a substantially cylindrical configuration; and

at least one memory retention unit being imbedded in said panel and constructed from a second material sufficiently flexible for responding to pressure thereon for deforming into said substantially cylindrical configuration and having sufficient memory characteristics for returning said panel body to its normal flat planar configuration when said pressure has been removed therefrom.

In rejecting these claims, the Examiner concluded that the combination of Rylander, Steinmetz and Mezzanotte would render these claims obvious. In making this rejection, the Examiner stated that it would have been obvious to provide the rod of Steinmetz in the plastic sheet of Rylander because "it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. which provides a material that meets the requirements and purpose of Rylander."

In response, the Applicant argued the non-obviousness of the claimed invention by submitting the affidavit of Mr. Nick Rylander, the named inventor in the Rylander reference. In his affidavit, Mr. Rylander indicated he reviewed the Steinmetz patent in view of his invention and that of the Applicant and concluded that "it is not at all obvious to combine the designs of Rylander and Steinmetz." He based this opinion on differences between the Steinmetz design and his design.

Additionally, it was argued that the Mezzanotte was non-analogous art. The basis for this argument was that Mezzanotte was directed toward the field of radial tires whereas the present invention is directed toward the field of lawn and trash bags. In other words, it was argued that Mezzanotte was not in the relevant field of endeavor.

It was also argued that Mezzanotte was not reasonably pertinent to the problem with which the inventor was concerned, i.e. the improvement of using trash bags. The basis for

this being Mezzanotte is directed toward the radial tire art and not the trash bag art and on a more specific level, Mezzanotte taught the creation of a stiff, rigid sidewall for a radial tire in order to “eliminate [the] drawback” of a flexible tire.

The Examiner, however, has maintained his rejections. Regarding the Affidavit of Mr. Nick Rylander, the Examiner completely dismissed Mr. Rylander’s statements. The Examiner stated that the Affidavit “is just a statement without proof or evidence (experiments, unexpected results, etc) for justification or verification therein.” First, this affidavit was not produced by the inventor, but rather the inventor of the primary referenced prior art. Mr. Rylander does not have any interest in the outcome of this matter. In fact, if he were to have such an interest, it would likely be one of the non-allowance to do the present invention being an improvement over his invention. In fact, in the Affidavit, Mr. Rylander took issue with how his invention was characterized by the Applicant. (A statement that the Examiner completed discounted as being not relevant). To broadly conclude it is “just a statement without proof” indicates that the Examiner did not assign this evidence any weight, which is highly improper. See MPEP 716.01(c). *See also In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the prima facie case of obviousness).

Additionally, it is clear the Examiner is confused regarding how to assess the Affidavit. The Examiner would like to see evidence of “experiments” or “unexpected results.” The Affidavit was directed toward whether one of ordinary skill in the art such as Mr. Rylander, a fact undisputed by the Examiner, would consider it obvious to combine references. There is no need for “experiments” and clearly there would be no “unexpected results” result therefrom. These are indicators when discussing an invention in light of prior art, not whether prior art is combinable.

Regarding the reliance to the Mezzanotte reference when maintaining his rejections, the Examiner attempted to argue a different rationale for his reliance thereon than set forth in his previous rejection. In his Advisory Action, he stated that he was only relying on Mezzanotte for the “broad teaching of motivation to embed a metal rod in a polymer.” (Advisory Action, p.6). This statement, however, conflicts with his earlier rationale for the reliance of the Mezzanotte that is “provides a material that meets the requirements and purpose of Rylander.” (Emphasis added.) According to the Examiner in the latest Office Action, Mezzanotte was relied upon to provide material that meets the purpose of Rylander, which was to provide a **flexible** panel. Thus, according to the Examiner’s statements, he relied upon Mezzanotte to provide flexible material having metal cords therein. It was only after the Applicant’s statements that Mezzanotte taught away from a flexible material by teaching the use of rigid material to avoid flexibility, did the Examiner state this more broad reason.

Moreover, the Mezzanotte reference is not a reference one of ordinary skill in the art would consider when attempting to solve the problem of improved lawn bag use. The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). As previously stated, the fields of endeavor are different, radial tires as contrasted to trash bags.

Regarding the second inquiry, reasonably pertinent to the problem that the inventor is concerned, the Examiner makes a conclusory statement in his Advisory Action, “Mezzanotte solves a specific problem and therefore does not need to be in the field of art of the inventor’s endeavor as stated in MPEP 2141.01(a).” First all inventions should solve a problem, but to

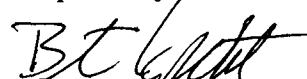
be considered analogous, they must be “reasonably pertinent” to the problem of the pending application. As previously stated, Mezzanotte was concerned with providing a stiff, non-flexible material. The problem facing the present invention, or that of Rylander, was to provide a flexible device, and not one that was rigid. Applying common sense, it is clear that one would not look toward a radial tire when seeking an improvement to trash bag, nor is it common sense for one to look toward a device that is desirous of being as stiff as possible when one needs something flexible. See *In re Oetiker*, 977 F.2d 1443, 1447 (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” Accordingly, Mezzanotte is not analogous art and the Examiner’s reliance thereon is not well founded.

Finally, Mezzanotte does not specifically disclose, teach or suggest the use of its stiff radial tires could be used in anything where flexibility is required, such as the present invention. Based on the above, the Examiner’s reliance on Mezzanotte is improper.

Conclusion

Based on the above, the Applicant respectfully submits the Examiner has failed to make a prima facie case of obviousness and the claimed invention is not rendered obvious by the references cited by the Examiner, and that the claims are in a condition for allowance.

Respectfully submitted,



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